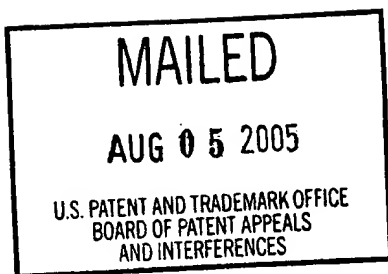


The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE ODOM and KAROLYN GEE



Appeal No. 2005-1071
Application No. 09/977,138

HEARD July 13, 2005

Before RUGGIERO, SAADAT, and NAPPI, **Administrative Patent Judges.**
NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 2 through 48 which constitute all the claims remaining in the application. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 2 through 48.

THE INVENTION

The invention relates to a video poker game where data representing a deck of cards are randomized (shuffled) and used to play a hand of cards, the

cards in the deck remaining for play are displayed to a player (i.e. the depleted deck). See page 4 of appellants' specification, field 34 in appellants' figures 1 and 2. The player may play several hands of poker without re-constituting (re-inserting the played cards and re-shuffling) the deck. A pay table, an indication of the payout for various hands, is also displayed to the user, the pay table is updated to remove any hands which are no longer achievable due to depletion of the cards from the deck. See page 12 of appellants' specification.

Claim 11 is representative of the invention and is reproduced below:

11. An electronic device for playing a [sic] hands of a card game according to the rules thereof utilizing data representing a deck of N playing cards:
 - a first data structure storing data representing each playing card of said deck;
 - a processor, said processor configured to include means for randomly arranging said playing card data into a random, serial order;
 - a video display;
 - means for a player to make a wager and prompt play of the game;
 - said processor, in response to prompting, configured to select and display at said display data from said first data structure representing a predetermined number of cards selected in order from said arranged data inventory to define an initial holding;
 - a control device for completing said initial holding according to the rules thereof by at least one of (1) replacing at least one card of the initial holding or (2) selecting additional cards, said processor configured to select and display at said display from said first data structure data representing each replacement or additional cards selected in order from said arranged data to define a final outcome for the hand of play;
 - said processor configured to display at said display data corresponding to the remaining constituency of said deck data depleted of said displayed card data;

said processor further configured to display data that said depletion has eliminated a final outcome; and
said processor configured to determine if said final outcome is a winning or losing outcome and to issue an award for winning a combination.

THE REFERENCES

The references relied upon by the examiner are:

Richardson	5,042,809	Aug. 27, 1991
Fuchs	5,630,753	May 20, 1997
Kinoshita et al. (Kinoshita et al.)	5,967,894	Oct. 19, 1999

THE REJECTIONS AT ISSUE

Claims 2 through 4, 6 through 14, 16 through 20, 22 through 30, 32 through 38 and 40 through 48 stand rejected under 35 U.S.C. § 103 as being obvious over Fuchs in view of Kinoshita. Claims 5, 15, 21, 31, and 39 stand rejected under 35 U.S.C. § 103 as being obvious over Fuchs in view of Kinoshita and Richardson. The Final Rejection, dated October 6, 2003, also provisionally rejects claims 1-36 under the judicially created doctrine of obviousness type double patenting in view of the claims of application 10/121,884, however this rejection was not addressed in the examiner's answer, accordingly we dismiss the appeal of this rejection.

Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 2 through 48 under 35 U.S.C. § 103.

Appellants argue, on page 9 of the brief:

Fuchs does show intra hand depletion, however it does not disclose (1) depletion which carries over to subsequent hands of play as set forth in claim 37 nor does it show (2) display of the elimination of outcomes which may occur as a result of depletion.

On pages 10-11 of the brief, appellants argue:

Those skilled in the art would interpret Fuchs to provide (1) a game having an initial deal, (2) with the next game being played by holding/discarding the symbols of the initial deal, i.e., first game to produce an outcome (game 1 outcome) and (3) a next game where the player can hold/discard symbols from the previous outcome (game 1 outcome) to, in essence "build" one or a series of outcomes. That is, Fuchs does not carry over deck depletion to the next hand as set forth in claim 37, but merely provides for deck depletion during the play of one hand, which may encompass a series of outcomes. Fuchs does not disclose or carry over deck depletion to the next hand.

On page 11 of the brief, appellants assert:

Fuchs does not disclose or suggest the display of information to the player of elimination of any outcome as a result of depletion as set forth in claim 37. Fuchs discloses the display of possible outcomes based upon the player's hold decisions.

Further, on page 12 appellants state:

[D]isplaying the probabilities of obtaining a winning outcome [as disclosed in Fuchs] is vastly different from displaying the outcomes which have been eliminated as a result of depletion.... Any eliminated outcomes would only become known based upon (1) the cards dealt to the player and (2) the player's hold decisions.

In response, the examiner asserts, on page 11 of the answer, that Fuchs does disclose that depletion carries over from hand to hand citing, column 9 lines 52-67 of Fuchs, with emphasis on lines 61-63 which states "from game to game the symbols offered to each player would be deducted from the originally existing symbols." Further, the examiner states on page 12 of the answer, "The additional teachings of Kinoshita et al. were used to provide support for the display of eliminated outcomes." On page 13 of the answer, the examiner asserts that Kinoshita teaches a pay table wherein outcomes that have been eliminated are displayed and that in combination with Fuchs teaches that displaying outcomes that have been eliminated because of depletion. The examiner states "[i]n gaming it is the combination of data that counts, thus motivation exists to apply Kinoshita et al. to Fuchs in order to provide clarity in the display to aid the player."

We disagree with the examiner's findings regarding Fuchs. In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Initially we note that claims 37 and 42 are the only claims that contain claim limitations which directly claim depletion of the deck from playing several

hands. Claim 37 contains the limitation “(g) to play subsequent hands repeating steps (b) –(f)” where steps (b)-(f) deplete the deck and step (a) is a step of storing a representation of each card in the deck (analogous to reconstituting and re-shuffling the deck). Claim 42 contains the limitation “(d) displaying a tally corresponding to the constituency of the deck data of said data structure depleted of said cards displayed in the play of preceding hands.” We find that the term “hand” has its customary meaning in card games, that is, the discrete part of the game in which wagers are paid, which is consistent with appellants’ use of the term in the specification. See page 2 lines 8-9 of appellants’ specification. Thus, we find that the scope of independent claims 37 and 42 explicitly includes displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion.

Further, we find that independent claims 11, 17, 27, 44 and 47 are implicitly directed to displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion. Independent claims 11, 17, 27 44 and 47 all contain limitations directed to displaying an indication of outcomes eliminated by depletion (claim 44 and 47 use the term exclusion, which we consider to be similar to depletion). We find that outcomes can not be eliminated by depletion unless the deck is depleted by several hands of play. Claim 11 identifies that the displayed data corresponds to “the remaining constituency of said deck data depleted of said

displayed card data.” Independent claims 17, 27, 44 and 47 contain similar limitations. Thus, the term depletion is the term that describes the process whereby cards become unavailable from the deck. If only one hand of cards is dealt from a fully constituted deck, we find no scenario where any winning outcome can be eliminated based upon the cards which are dealt (depleted from the deck). It is only when more than one hand is dealt from the deck that winning outcomes can be eliminated because of depletion. Thus, we find that these claims are limited to inter-hand depletion.

In summary, we find that the scope of all the independent claims, claims 11, 17, 27, 37, 42 and 44¹, includes displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion.

We acknowledge that the sections of Fuchs the examiner relies upon appear to disclose depletion of the group of symbols (cards in a deck) over several games. However, in our review of Fuchs we find that Fuchs' uses the term game to mean an additional play of cards, i.e. Fuchs uses the term game to both describe the inter hand deal of cards and the intra hand deal of cards. See for example Fuchs states, in column 6, lines 20-25:

¹ We note the following ambiguities in the claims. Claims 17, 37, 42 and 44 are all method claims and include the step of “a player making wages” (i.e. a person); this step is ambiguous as it is impossible for a person to be a method step. Further, as agreed upon by counsel at oral hearing, claim 44 more properly reads “displaying data corresponding to a *hand* outcome eliminated by exclusion.”

In the present case, since it is a type of poker game that is being played, the computer unit 5 has suggested that two game symbols 3', namely the two aces, should be stored and at the same time it displays the possible ways of winning the next game by obtaining five, four or three aces and the possible ways of winning are assigned various values in the display fields

Thus, we find it clear that Fuchs is using the term game to include the deal of cards within a hand of poker. Further, we find no examples in Fuchs that discuss the deck of cards is not being reconstituted and randomized between segments of play where wagers are distributed (i.e. hands of poker). Rather, we find that Fuchs is ambiguous as to whether the deck of cards is reconstituted and randomized, or is allowed to be depleted, between hands.

We find that Kinoshita teaches a video poker game, where based upon the player's selection of which cards to hold (appellants' claimed step of selecting and Fuchs step of storing) and the pay table of possible outcomes is adjusted based upon what is achievable. See figures 8(a)-8(c) and description in column 7, lines 25-62. We find no teaching in Kinoshita that the deck is not reconstituted and randomized (i.e. allowed to deplete) between hands of the poker game. Further, we find that Kinoshita does not teach displaying winning outcomes eliminated because of depletion. We find that Kinoshita teaches that the outcomes are eliminated based upon the hold decisions made by the player and not the depletion of the deck as claimed. Thus, we find that Kinoshita provides no teaching or suggestion of displaying winning outcomes eliminated because of depletion.

As we consider the scope of independent claims to include the limitations of: displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion; and we find that the reference's teaching directed to this limitation is ambiguous, we find that the examiner has not carried the burden of proving that the claims are unpatentable. Accordingly, we will not sustain the examiner's rejection of Claims 2 through 4, 6 through 14, 16 through 20, 22 through 30, 32 through 38 and 40 through 48 under 35 U.S.C. § 103 as being obvious over Fuchs in view of Kinoshita.

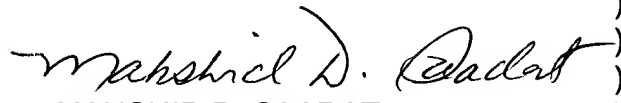
We next consider the examiner's rejection of claims 5, 15, 21, 31, and 39 under 35 U.S.C. § 103 as being obvious over Fuchs in view of Kinoshita and Richardson. Claims 5, 15, 21 and 31 ultimately depend upon claims 37, 11, 17 and 27, respectively, and as such the scope of these claims includes the limitation of displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion. Thus, we do not find that Richardson teaches modifying the video poker games of Fuchs or Kinoshita to include this limitation. Accordingly, we will not sustain the examiner's rejection of claims 5, 15, 21 and 31.

In summary we will not sustain the examiner's rejection of claims 2 through 48 under 35 U.S.C. § 103. The appellants and the examiner should take appropriate action to clarify the ambiguities noted in claims 17, 37, 42 and 44.

REVERSED


JOSEPH F. RUGGIERO

Administrative Patent Judge


MAHSHID D. SAADAT

Administrative Patent Judge


ROBERT E. NAPPI

Administrative Patent Judge

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Appeal No. 2005-1071
Application No. 09/977,138

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